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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/994,758	12/19/97	NISHI K	XA-7889A-RE

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EXAMINER  
MATHEWS, A

ART UNIT PAPER NUMBER  
2851 4

DATE MAILED: 01/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/994,758**

Applicant(s)  
**NISHI**

Examiner  
**Alan Mathews**

Group Art Unit  
**2851**



☒ Responsive to communication(s) filed on 10-20-98 (preliminary amendment)

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-128 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-128 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/377,504.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Oath/Declaration***

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Paragraph 7) of Applicant's "DECLARATION IN SUPPORT OF REISSUE APPLICATION" has only a general statement that "The failure to present, in my original application, claims of the scope of claims 35 and 36 of my reissue application constitutes an error ----". MPEP § 1414 states on page 1400-13 under **II**:

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or the original claim, and how it renders the original patent wholly or partly inoperative or invalid.

Applicant has not identified a word, phrase, or expression in the original claim and how it renders the original patent wholly or partly inoperative or invalid.

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2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

A. It does not state whether the inventor is a sole or joint inventor of the invention claimed.

B. It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

C. It lacks a statement required by 37 CFR 1.175 (a)(2)

### *Claim Rejections*

3. Claims 1-128 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth in paragraph 1) above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion in paragraph 1) above in this Office action.

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4. Claims 1-128 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth in paragraph 2) above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion in paragraph 2) above in this Office action.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9 and 33 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent Document 63-128713 cited in Applicant's PTO-1449. The Japanese Patent Document 63-128713 discloses a mask 24 and a substrate 25 (unfortunately, the reference occasionally mislabels the mask as element 25, thus causing some confusion.). Page 5, lines 20-23 of the translation of the Japanese Patent Document 63-128713 states "the positional relationship between the mask and the substrate is deviated relative to each other by using a fine feeding mechanism for the mask or the substrate in accordance with the scanning position while performing exposure scanning." Page 7, lines 17-20 discloses that the mask can be finely

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displaced by motors 40, 41 and 42. Page 9, line 25, and page 10, lines 1- 4 state "any distortion is corrected by deviating the positions of the mask and substrate relative to each other in an optimum displacement pattern determined by measurement conducted beforehand **by a fine feed mechanism for the mask or the substrate** while performing exposure scanning". This fine feeding is the adjustment mechanism. Scanning frame 26 is movable on rails 30 and 31 by way of air bearings 32 and 33. With respect to claim 36, element 28 is an alignment optical system for measuring any positional deviation of the mask 24 and the substrate 25 (see page 7, lines 3-6), which therefore **detects a positional deviation between the mask and the plate.**

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Genovese, Shafer et al, Jain, Magome, and Allen are cited for the same reasons they were cited in the parent patent. The patent to Takabayashi et al is cited to show wafer stages 8 and 9. The patents on the PTO 1449 are cited for the same reason applicant cited them in his INFORMATION DISCLOSURE STATEMENT.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Alan Mathews at telephone number (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM Eastern Time.

Any inquiry of a general nature or related to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1782. The fax phone number for this Group is (703) 305-34[31,32].



**Alan A. Mathews**  
Primary Examiner

AAM

January 13, 1999